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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/829,943	04/11/2001	Holger Glaum	204205US0	7697
22850	7590	04/14/2004	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			WOOD, ELIZABETH D	
			ART UNIT	PAPER NUMBER
			1755	

DATE MAILED: 04/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	09/829,943		GLAUM ET AL.	
	<b>Examiner</b>		<b>Art Unit</b>	
	Elizabeth D. Wood		1755	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 February 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) 16-19, 21 and 22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15, 20 and 23-35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>2/23/04</u> .   | 6) <input type="checkbox"/> Other: _____                                    |

***Priority***

The request for foreign priority filed February 23, 2004 is hereby acknowledged. It has not been granted at this time however. The request itself was not signed. Additionally, only the cover page of the priority document was received. The entire document must be submitted.

***Election/Restriction***

Claims 16-19, 21 and 22 remain withdrawn from consideration for the reasons set forth in the previous office action.

The election is modified to the extent that the requirement for election of the particular binder is hereby withdrawn.

***Claim Rejections - 35 USC § 112***

Claims 13, 14 and 15 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

These claims are broader than the claim from which they depend. For example, they identify the filler as silica, which is broader than the independent claim.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicants are advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-15, 20 and 23-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,213,846 to Tsuneta et al., U.S. Patent No. 6,270,855 to Jung et al., U.S. Patent No. 4,138,527 to Malek, U.S. Patent No. 5,106,675 to Ara et al. or U.S. Patent No. 6,191,122 to Lux et al, each taken individually.

As discussed in the previous office action, applicants' claims are drawn to a coating composition comprising a hydrophobic filler and a binder. At this point, some of the claims have been amended to require the filler be selected from the group

consisting of precipitated silica, pyrogenic silica, a silicate, or a synthetic pigment and the search has been expanded to include these fillers.

Also as mentioned in the previous office action, claim 20 is considered to invoke the sixth paragraph of 35 USC 112 and accordingly the means for binding and the means for rendering the particle hydrophobic are considered limited to those set forth in the instant specification and obvious variants. However, in accordance with the election requirement, the examination of this claim is also commensurate with the broadened search.

Each of the applied references disclose coating compositions comprising particular silica materials in combination with binders such as latex, substantially as claimed herein by applicants.

The only difference between the disclosed compositions and the instant claims is that they do not recite the exact carbon content of the filler materials. However, the instant claims would have been obvious because the particular types of silica materials being used by the references have carbon contents that overlap those claimed by applicants. An overlapping range has long been held to constitute a prima facie case of obviousness. Since the compositions of the references and the claims have the same utility, the skilled artisan would have been expected to optimize the working range for the stated purpose and so arrive at the claimed invention.

Regarding claim language such as "consisting essentially of", it is pointed out that since the reference compositions are for the same purpose as the claimed, i.e. coating compositions, any additional substances disclosed by the references would be

within the scope of the instant claims because there is no apparent effect on the basic and novel characteristics of the composition.

See particularly Example 2 of Malek which employs Aerosil R 972 which has a carbon content of 0.6-1.2. See Example 14 of Jung et al., which employ Cabosil TS610 or Aerosil 972. Cabosil TS610 has a carbon content of 0.7-1.0. See column 4 of Tsuneta et al. which teaches Aerosil 972, which has a carbon content of 0.6-1.2 and Aerosil R202, which has a carbon content of 3.5-5. See column 4 of Ara et al. which teaches Aerosil R972, which has a carbon content of 0.6-1.2. See column 2 of Lux, which teaches partially hydrophobic silicas having a methanol watability of 10-49. These silicas would inherently have a carbon content overlapping that claimed herein by applicants, and Lux et al. specifically teach that the defoaming agents of their invention have utility in the industry of coating.

Any minor differences in the limitations of the dependent claims have been considered. This statement is meant to include limitations such as particle size , surface area, surface treating agents and so forth. These limitations are standard in this field of technology and fairly shown by the prior art of record in analogous coating compositions. See, for example, U.S. Patent No. 4,274,883 to Lumbeck et al.

Furthermore, any such differences are deemed to be result-effective

variables that one of ordinary skill in the art would be expected to manipulate to advantage. Additionally, such limitations can be considered to have been simply known as conventional to the artisan practicing in the art at the time the invention was made and/or were common practices which were so well known in the art that they would have been taken for granted. MPEP 706.02(a).

If applicant believes that one or more limitations are critical to the invention, then applicant should amend the claims to reflect such critical limitations as well as indicate where in the specification such critical limitations were discussed and demonstrated.

The limitations of all claims have been considered and are deemed to be within the purview of the prior art.

### ***Response to Arguments***

Applicants' arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Applicants' amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicants are reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth D. Wood whose telephone number is 571-272-1377. The examiner can normally be reached on M-F, 5:30-2:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Bell can be reached on 571-272-1364. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Elizabeth D. Wood

**ELIZABETH D. WOOD  
PRIMARY EXAMINER**